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REMARKS

Applicant has reviewed and considered the Office Action mailed on March 7, 2006, and the references cited therewith. Claims 1, 2, 5, 7-10, 13, and 14 are pending. Claims 1, 5 and 13. No new matter has been added. Applicant respectfully requests reconsideration and allowance of all claims in view of the following remarks.

Claims 1, 2, 13 and 14 patentable under §112

Claims 1, 2, 13 and 14 were rejected under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement.

Claim 1 is amended to change "bitmap for the broadcast video presentation" to "the broadcast video presentation," which is supported in the application as originally filed. As a result, the rejection of claims 1, 2, 13, and 14 is moot and Applicant respectfully requests that the rejection be withdrawn.

Claims 5 and 8 patentable over Ellis under §102

Claims 5 and 8 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,986,650 to Ellis et al. ("Ellis").

According to MPEP §2131, to anticipate a claim under §102, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

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Ellis fails to teach each and every element of the claimed invention. For example, Ellis fails to teach encoding, at the headend, the channel information windows, transmitting, from the headend to the set top terminal, the channel information windows, and decoding, at the set top terminal, the broadcast video displays and the channel information windows.

As stated in previous responses, prior similar windows have been generated at a set-top terminal. The present invention generates such a window at a server in a cable headend or other distribution center. Because the window is generated at a server in accordance with the present invention, rather than at a terminal, there terminal may be simplified and made less expensive.

Ellis discloses that program schedule data, application software, bit maps for screen configuration, the graphic symbol or logo may be downloaded or stored. An electronic program schedule system includes a microcontroller to convert the digital data information, which includes channel and program information, to RGB format for the overlay device. Thus, Ellis merely receives information and the microcontroller at the receiver performs the necessary functions to create the overlay. The information of Ellis is not equivalent to channel information windows. Ellis does not encode windows at the headend. Moreover, Ellis does not transmit encoded windows from the headend to the set top terminal. In addition, Ellis does not decode the received encoded windows at the set top terminal.

Therefore, this rejection should be withdrawn.

Claims 1, 2, and 7 patentable over Ellis/Hoarty under §103

Claims 1, 2, and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of U.S. Patent No. 5,485,197 to Hoarty ("Hoarty").

According to MPEP §2143, to establish a prima facie case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the

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prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combination of Ellis and Hoarty fails to teach or suggest all the elements of the claimed invention. For example, the combination fails to teach or suggest encoding, at the headend, a bitmap for the channel information window; transmitting, from the headend to a set top terminal, the bitmap for the channel information window; and decoding, at the set top terminal, the broadcast video displays and the channel information windows.

Claim 1 recites, *inter alia*,

A method, comprising:
generating, at a headend, at least one bitmap for a channel information window;
encoding, at the headend, a broadcast video presentation and the bitmap for the channel information window, the broadcast video presentation being programming from one of a plurality of channels;
transmitting, from the headend to a set top terminal, the broadcast video presentation and the bitmap for the channel information window;
receiving, at the set top terminal, a signal to activate the channel information window;
decoding, at the set top terminal, the broadcast video presentation and the bitmap for the channel information window; and
compositing, at the set top terminal, the bitmap for the channel information window and the broadcast video presentation to produce a video stream for a display so that the channel information window overlays and obscures at least a portion of the broadcast video presentation on the display. (emphasis added).

As stated above, prior similar windows have been generated at a set-top terminal. The present invention generates such a window at a server in a cable headend or other distribution center. Because the window is generated at a server in accordance with the present invention, rather than at a terminal, there terminal may be simplified and made less expensive. Thus, the window is remotely generated and then transmitted to the set top terminal. This feature is not taught or suggested by the references.

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Ellis discloses that program schedule data, application software, bit maps for screen configuration, the graphic symbol or logo may be downloaded or stored. An electronic program schedule system includes a microcontroller to convert the digital data information, which includes channel and program information, to RGB format for the overlay device. Thus, Ellis merely receives information and the microcontroller at the receiver performs the necessary functions to create the overlay. The information of Ellis is not equivalent to a channel information window. Ellis does not encode windows at the headend. Moreover, Ellis does not transmit encoded windows from the headend to the set top terminal. In addition, Ellis does not decode the received encoded windows at the set top terminal.

Hoarty discloses an interactive home information system for providing interactive cable television services to a plurality of subscribers. The system includes a "node" which is in communication with the headend of the system and a group of subscriber home interface terminals. The node operates to selectively distribute information services obtained from the headend to ones of the terminals. The system includes circuitry for generating a display of a carousel on a subscriber's television. The displayed carousel includes a plurality of faces wherein an established one of the faces lists at least one available choice which can be selected by the subscriber via a displayed cursor. The system further includes circuitry for causing an apparent rotation of the displayed carousel in order to display additional choices on the established face. Hoarty also does not encode windows at the headend. Moreover, Hoarty also does not transmit encoded windows from the headend to the set top terminal. In addition, Hoarty also does not decode the received encoded windows at the set top terminal.

Therefore, neither Ellis nor Hoarty teaches or suggests encoding, at the headend, the bitmap for the channel information window; transmitting, from the headend to a set top terminal, the bitmap for the channel information window; and decoding, at the set top terminal, the bitmap for the channel information window. Thus, claim 1 is allowable under §103.

Claims 2 and 7 depend directly from claims 1 and 5 respectively and, thus, inherit the patentable subject matter of claims 1 and 5 respectively, while adding additional

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elements and further defining elements. Since the rejection for claims 1 and 5 have been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Ellis in view of Hoarty supplies that which is missing, this ground of rejection cannot be maintained. Therefore, claims 2 and 7 are allowable under §103.

Claims 9 and 10 patentable over Ellis/Bolanos under §103

Claims 9 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of U.S. Patent No. 5,793,364 to Bolanos (Bolanos).

Claims 9 and 10 includes the features that a bitmap for the window is remotely generated and then transmitted to the set top terminal for decoding. This feature is not taught or suggested by the references.

Ellis discloses that program schedule data, application software, bit maps for screen configuration, the graphic symbol or logo may be downloaded or stored. An electronic program schedule system includes a microcontroller to convert the digital data information, which includes channel and program information, to RGB format for the overlay device. Thus, Ellis merely receives information and the microcontroller at the receiver performs the necessary functions to create the overlay. The information of Ellis is not equivalent to a channel information window. Ellis does not encode windows at the headend. Moreover, Ellis does not transmit encoded windows from the headend to the set top terminal. In addition, Ellis does not decode the received encoded windows at the set top terminal.

Bolanos discloses a method and system are provided for associating playback of multiple audiovisual programs with one graphic interface element in a graphical user interface. Primary and secondary audiovisual programs are associated with the graphic interface element. A primary audiovisual program is played back when the user selects the graphic interface element. The secondary audiovisual program is played back at pseudorandom intervals without user input. The secondary audiovisual program draws the user's attention to the graphic interface element. Thus, Bolanos also does not encode windows at the headend. Moreover, Bolanos also does not transmit encoded

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windows from the headend to the set top terminal. In addition, Bolanos also does not decode the received encoded windows at the set top terminal.

Neither Ellis nor Bolanos teaches or suggests a bitmap <u>for</u> the window is remotely generated and then transmitted to the set top terminal for decoding. Thus, claims 9 and 10 are allowable over the proposed combination of Ellis in view of Bolanos under 35 U.S.C. 103.

Claim 13 patentable over Ellis/Hoarty/Bolanos under §103

Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis and Hoarty as applied to claim 1 above, and further in view of U.S. Patent No. 5,793,364 to Bolanos et al. ("Bolanos").

Claim 13 depends directly from claim 1 and, thus, inherits the patentable subject matter of claim 1, while adding additional elements and further defining elements. Since the rejection for claim 1 has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Ellis, Hoarty, and Bolanos supply that which is missing, this ground of rejection cannot be maintained. Therefore, claim 13 is allowable under §103.

Claim 14 patentable over EllisHoarty/MacInnis under §103

Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis and Hoarty as applied to claim 1 above, and further in view of MacInnis U.S. Patent No. 5,951,639 ("MacInnis").

Claim 14 depends directly from claim 1 and, thus, inherits the patentable subject matter of claim 1, while adding additional elements and further defining elements. Since the rejection for claim 1 has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Ellis, Hoarty, and MacInnis supply that which is missing, this ground of rejection cannot be maintained. Therefore, claim 13 is allowable under §103.

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CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and passage of the claims to allowance. If, however, the Examiner believes that there are any unresolved issues, it is requested that the Examiner telephone Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: _8/3/06_

Eamon J. Wall
Registration No. 39,414
Attorney for Applicant

PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808

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